

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Michael Reed et al.

Application No.: 08/113,955

Confirmation No.: 3543

Filed: August 31, 1993

Art Unit:

For: MULTIMEDIA SEARCH SYSTEM

Examiner:

**PETITION TO HAVE 3<sup>rd</sup> PARTY OPPOSITION BE EXPUNGED AND PETITION UNDER  
37 C.F.R. §1.59(b) FOR EXPUNGEMENT OF PRESENT PETITION**

MS Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is a Request that the OPPOSITION TO "PETITION UNDER 37 C.F.R. §1.53(b) and/or 37 C.F.R. §1.182 FOR GRANT OF A FILING DATE AND AMENDMENT OF APPLICATION" (hereafter "Opposition") filed electronically on January 9, 2008 by Raymond W. Green of the Brinks Hofer Gilson & Lione firm be expunged from the file of the present application, for the reasons given below. Should this Petition be granted, it is further requested that the present Petition be expunged under 37 C.F.R. §1.59(b) since this entire Petition is directed to impropriety of Opposition filed by Mr. Green, which Opposition will have been expunged from the file.

**OPPOSITION SUBMITTED BY MR. GREEN**

It is initially noted that the Petition filed by Abraham HersHKovitz on November 2, 2007 and the Amendment of November 8, 2007, were filed in an ex parte proceeding in a patent

application, with the full concurrence and authorization of the attorneys of record and the owner of the present application. The fact that Abraham HersHKovitz provided his PTO registration number with his signature makes it abundantly clear that in accordance with 37 C.F.R. §1.33 or §1.34, Petitioner was “A patent practitioner not of record who acts in a representative capacity under the provisions of §1.34” (37 C.F.R. §1.33 (b)(2)) and “When a patent practitioner acting in a representative capacity appears in person or signs a paper in practice before the United States Patent and Trademark Office in a patent case, his or her personal appearance or signature shall constitute a representation to the United States Patent and Trademark Office that under the provisions of this subchapter and the law, he or she is authorized to represent the particular party on whose behalf he or she acts. In filing such a paper, the patent practitioner must set forth his or her registration number, his or her name and signature.” (37 C.F.R. §1.34). While Mr. Green is not in a position to question the level of authority given to Mr. HersHKovitz by Mr. Grossman, the attorney of record, the present Petition is signed by both, Mr. HersHKovitz, and Mr. Grossman, so as to remove any doubt as to delegation of authority.

The same is not true of the filer of the Opposition. The Opposition filed on January 8, 2008 by Raymond Green was filed without the authority required under 37 C.F.R. §1.33 or §1.34. In fact, the Opposition is simply a prejudicial document improperly filed in an *ex parte* proceeding by a party that has no standing in these proceedings.

#### POINTS OF DISCUSSION IN OPPOSITION

This Petition will not attempt to respond point by point to the baseless and misleading points made in the Opposition. Rather, this petition will attempt to point out that the Opposition was improperly filed in an *ex parte* proceeding by a 3<sup>rd</sup> party not entitled to participate in such proceedings, and therefore should be expunged. The major points discussed in the Opposition are:

- a. Prosecution File History of application 08/113,955 and its parent;
- b. Request by Mr. Green that the Petition filed on November 2, 2007 on behalf of Applicant be dismissed or denied with suggested rationale given for the dismissal or denial;

- c. Litigation background and discussion of reexamination proceedings;
- d. Assertion that Abraham HersHKovitz of HersHKovitz & Associates had no explicit authority to file the petition for a filing date since Jon Grossman, of Dickstein Shapiro, was the attorney of record;
- e. Since Petitioner invoked 37 C.F.R. §1.182, that same rule, i.e., “questions not specifically provided for” permits a 3<sup>rd</sup> party to file the Opposition.

#### APPLICANT’S POSITION ON OPPOSITION

Applicant urges the PTO to expunge the Opposition as a document filed by a person or entity having no standing in this ex parte proceeding and one that is prejudicial, misleading, inaccurate, and of no value to the PTO deciding official or the present prosecution file. More specifically, with regard to the points raised above:

- a. The prosecution file history of application 08/113,955 and its parent, including any relevance of reexamination proceedings, are available to the PTO deciding official. As such, the Opposition has no relevance to the Petition for a filing date;
- b. The PTO deciding official is quite capable of rendering an appropriate decision on the filing date petition, there being no need for suggested decisions, nor suggested rationale for those decisions, by a third party having no standing in the matter;
- c. The litigation related benefits that would accrue to the Applicant from a grant of the filing date petition and the benefits that would accrue to Opposer’s client from a dismissal or denial of the filing date petition are not and should not be relevant to a fair decision by the PTO on the merits of the filing date petition;

d. Jon Grossman is an experienced patent attorney with the Dickstein Shapiro firm, having practiced patent law for over 20 years. While he has handled a number of petitions, fortunately, they occurred on a very infrequent basis and involved rather simple procedural issues. When he was made aware of the filing date problems encountered relative to the above-captioned application and the related priority benefits in the patent that matured from a continuation application filed from the above-captioned application, he inquired with other colleagues as to someone they could recommend who could assist with a specialized petition issue. Eventually, he was referred to Abraham Hershkovitz, registered to practice before the USPTO and a former Petitions Examiner and Director of the USPTO Office of Petitions. Mr. Hershkovitz authored "Petitions Practice Within the Patent and Trademark Office on Patent Matters", which was published in the March 1998 Journal of the Patent and Trademark Office Society (*see Exhibit 1*) and was until 2006 the authoritative practice on the PTO's own website (<http://www.uspto.gov/web/offices/pac/dapp/opla/petition.htm>). Currently, that site re-directs the viewer to an updated version of the PTO authoritative practice on petitions (<http://www.uspto.gov/web/offices/pac/dapp/petitionspractice.html>). After consulting with his client and owner of the patent that matured from the continuation application which claims priority benefits under 35 U.S.C. §120 to the above-captioned application, the Encyclopaedia Britannica, a decision was made to engage Mr. Hershkovitz for assistance with preparing the Petition for a filing date as well as a Petition to make amendatory changes in an abandoned application. Mr. Hershkovitz prepared the Petition and Amendment and after they were reviewed and approved by Mr. Grossman, he filed them with the USPTO.

e. As experienced practitioners know, amendments can be requested to be made routinely in pending applications. Once a patent issues or an application goes abandoned, amendments can no longer be requested on a routine basis. In an abandoned application, for instance, an amendment can only be made upon grant of a Petition under 37 C.F.R. §1.182. Additionally, a filing date may be obtained under certain circumstances by filing a petition under 37 C.F.R. §1.182 (see paragraph 5b on the USPTO current website at <http://www.uspto.gov/web/offices/pac/dapp/petitionspractice.html>). Thus, Applicant's filing of a

Petition under 37 C.F.R. §1.182 was entirely appropriate and recommended by the PTO's own petition guidelines. Filing an Opposition to a Petition filed by Applicant by a party having no standing is not a "question not specifically provided for" under 37 C.F.R. §1.182, as the regulations are replete with prohibition of such filings (see 37 C.F.R. §1.33, §1.34, §1.291, etc.).

### CONCLUSION

Applicant requests, for the reasons given above, that the Opposition filed on January 9, 2008 be expunged from the file of the above-identified application.

In the event that the present Petition is granted and the Opposition is expunged, the present Petition may make the file history of the above-identified application confusing, as it would include reference to a non-existing document. As such, if the Opposition is expunged, Applicant further requests under 37 C.F.R. §1.59(b) that the present Petition also be expunged. To the extent that any filing fees, petition fees or other fees are owed to the Patent Office regarding the above-captioned Application, the Commissioner is authorized to charge such fees to Petitioner's Deposit Account No. 50-2929, making reference to docket number J8300.1.

Dated: February 5, 2008

Respectfully submitted,

By 

Abraham HersHKovitz

Registration No.: 45,294

**HERSHKOVITZ & ASSOCIATES, LLC**

**2845 DUKE STREET**


**ALEXANDRIA, VA 22314**

**(703) 370-4800 (Voice)**

**(703) 370-4809 (Fax)**

**patent@hershkovitz.net**

**http://www.hershkovitz.net**

By   
Jon D. Grossman  
Registration No. 32,699

**DICKSTEIN SHAPIRO LLP**  
**1825 EYE STREET, N.W.**  
**WASHINGTON, DC 20006**